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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/000,468	12/04/2001	Paul Chen	2908.P8	2293

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EXAMINER
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ARAQUE JR, GERARDO

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/000,468		CHEN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Gerardo Araque Jr.		3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☒ Claim(s) 25 and 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4-12-2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12-4-01 &amp; 9-24-03</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group 1, claims 1 - 40 in the reply filed on April 21, 2006 is acknowledged. The traversal is on the ground(s) that Element (B) of section 808.2 calls for a showing that, if the groups are classified together, that it must be shown that each invention was the subject of separate inventive effort. This is not found persuasive because in regards to claims 1 – 40, information is uploaded to a server, from a first location, and used to determine a third piece of identification information, which would be the same identification information that is inputted at the second location. In regards to claims 41 – 47, information is uploaded to a server, from a first location, and used to determine a third piece of identification information, which is not the same as the identification information that is being inputted at the second location but somehow correlated to the identification information being inputted at the second location.

### ***Claim Objections***

1. **Claims 25 and 34** are objected to because of the following informalities: For clarification purposes device identification information should read as printing device identification information. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claim 4** recites the limitation "the hotel" in **line 3 of claim 4**. There is insufficient antecedent basis for this limitation in the claim.

4. **Claim 25** recites the limitation "the device" in **line 5 of claim 25**. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1 – 3, 5, 9, 12 – 15, 18, 23 – 25 and 27 – 35** are rejected under 35 U.S.C. 102(e) as being anticipated by Chan et al. (US Patent 6,378,070 B1).

7. In regard to **claims 1, 9, 14, 18, 24, 27, 29, 31, 33, and 35**, Chan discloses a method and network system using secure printing where the user uploads a selected document, identifying the intended recipient for the document, and, inherently, location information (Column 2 Lines 15 – 19). The location information is inherently uploaded with the print data information so that the system knows where the print data information is being uploaded. This is mostly seen in offices and college campuses where multiple users from multiple computers are using the same printers. The printer must receive the location information in order to determine the proper identification information of the logged-in user requesting the print job. Once the proper identification information has

been identified the printer would then print a cover page containing the identification information with the correlated print data information.

Chan also discloses that a smart card is used within the system as an option to retrieve the encrypted information (Column 5 Lines 6 – 9). As a result, it must be inherent that when an individual uploads the identification information of the intended recipient the system would, consequently, correlate the identification information with the key information (smart card). Furthermore, a document store is connected to the network, which receives and stores encrypted document files and associated user identities. “The document store 130 also receives requests to forward to specified locations encrypted document files having a specified identity (Column 3 Lines 54 – 61).” Chan also discloses the recipient providing the printing apparatus with a second identifier (identification information) to receive documents from the print server (Column 2 Lines 22 – 26). Once the second identifier is confirmed, which was inputted at the printing apparatus, the print data information is forwarded to the printing apparatus to have it printed (Column 2 Lines 27 – 34).

8. In regards to **claim 2**, it is inherently included that if multiple computers are connected to the same network some type of identifier must be assigned to the computer, such as the IP Address or Network Address.

9. In regards to **claim 3**, it is inherently included that when connecting a computer to an existing network the server must assign it an identifier, such as an IP Address or Network Address.

10. In regard to **claims 5, 12, 23, 25, 28, 30, 32, and 34**, Chan discloses a directory server, which has access to a database of user-specific information, known as user-profiles (Column 3 Lines 35 – 37). “The directory server **120** is arranged to receive from requesting processes requests for specific information for particular users, and returns the specific information to the requesting process, whenever possible (Column 3 Lines 37 – 41).” Moreover, Chan discloses that it is, “...necessary for a printer to identify itself in enough detail that the billing system **150** could allocate billed funds to the printer’s owner (Column 5 Lines 55 – 57).”

11. In regards to **claim 13**, Chan discloses, “...the document store **130** can be a modified print spooler or print server process which has access to a large amount of data storage...(Column 3 Lines 62 – 64).”

12. In regards to **claim 15**, Chan discloses a method and network system using secure printing where the user uploads a selected document, identifying the intended recipient for the document, and, inherently, location information (Column 2 Lines 15 – 19). It is inherently included that when connecting a computer to an existing network the server must assign it an identifier, such as an IP Address or Network Address.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 4 and 36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US Patent 6,378,070 B1) in view of Newton (Newton's Telecom Dictionary 20<sup>th</sup> Edition).

15. In regard to **claims 4 and 36**, it would have been obvious to one of ordinary skill at the time of the invention that if the printing network as disclosed by Chan were to be used in a hotel, a hotel server would be used. The function that is being carried out would be the same regardless of where the server is as is stated by Newton (Newton Page 737 Server).

16. **Claims 6 – 8, 10 – 11, 16 – 17, 19, 20, 21 – 22, 26, and 37 – 38** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US Patent 6,378,070 B1).

17. In regard to **claims 6 – 8, 10 – 11, 16 – 17, 19, 21 – 22, 26, and 37 – 38**, it would have been obvious to one of ordinary skill at the time of the invention that if the printing network as disclosed by Chan were to be used in a hotel, the location information must comprise hotel information and the server to be used must be a hotel server. The function that is being carried out would be the same regardless of where the printing network, as disclosed by Chan, was located. Regarding the identification information, it is old and well known that various forms of identification can be used depending on the situation. If the case of a hotel it would have been obvious that the identification information would be the room key information. It is old and well known that when staying at a hotel, or the like, information is kept under the room that you stayed at, the

credit card used to pay for the stay, and/or the last name and first name of the individual staying and/or paying for the hotel room.

18. In regards to **claim 20**, it would have been obvious that if an individual was staying at a hotel and using the hotel's network services user identification must be given to the individual by the hotel in order to use the hotel's network services.

19. **Claims 39 – 40** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al. (US Patent 6,378,070 B1) in view of Tognazzini (US Patent 6,195,420 B1).

20. In regards to **claim 39**, Chan is disclosed above but fails to teach printing billing information.

Tognazzini, however, does teach a system where a hotel guest receives a printed copy of the bill. As a result, the Tognazzini discloses that the invention allows a hotel guest increased flexibility in determining when the bill is prepared and how disputes over errors or omissions are resolve (Column 1 Lines 61 – 64).

Therefore, it would have been obvious to one of ordinary skill at the time of the invention in view of the teachings of Tognazzini to modify Chan to have an option of printing billing information in order to allow a hotel guest increased flexibility in determining when the bill is prepared and how disputes over errors or omissions are resolve.

21. In regards to **claim 40**, Tognazzi discloses that in-room checkout systems are offered by many hotels in order to permit a guest to view the bill and authorize payment (Column 1 Lines 11 – 12).



***Conclusion***

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following relevant prior art disclose methods and systems of printing over a network:

- a. US Patent: 5,867,633; 6,067,352; 5,930,465; 6,714,964 B1; 6,978,299 B1; 6,307,640 B1;
- b. Pub. No.: US 2002/0015179 A1

The following relevant prior art disclose methods and systems of printing over a network through user authentication:

- c. US Patent 5,633,932

The following relevant prior art disclose method verifying information for a transaction:

- d. US Patent 5,826,245

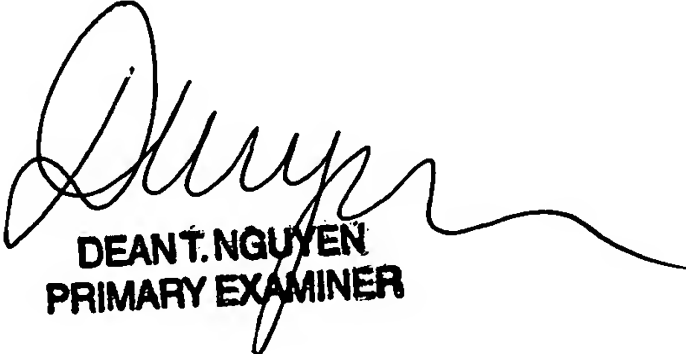
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is (571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GA  
June 8, 2006

  
**DEANT. NGUYEN**  
**PRIMARY EXAMINER**